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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,289

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EXAMINER

HOFFMAN, SUSAN COE

ART UNIT

PAPER NUMBER

1655

NOTIFICATION DATE

DELIVERY MODE

10/09/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
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Office Action Summary	Application No. 10/531,289	Applicant(s) UEHARA ET AL.	
	Examiner Susan Coe Hoffman	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 19, 20, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 19, 20, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed June 30, 2008 has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 16, 19, 20, 25 and 26 are pending.

Election/Restrictions

3. Applicant's election with traverse of Glycyrrhiza glabra extract in the reply filed on June 30, 2008 is acknowledged. The traversal is on the ground(s) that the lack of unity is improper because the restriction requirement does not establish that there is a lack of corresponding special technical feature between the different species. This is not found persuasive because each of the different species is drawn to a distinct plant extract composition. Thus, each of the species does not have a common structural element. Therefore, a person of ordinary skill in the art would not expect these distinct plant extract compositions to function equivalently. In addition, the common element between the different species is that they are used in combination with claimed ingredient (A). This ingredient is known in the art as demonstrated by Tamai (US 6,313,214). Therefore, there is a lack of corresponding technical feature. Thus, the different species lack unity.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 16, 19, 20, 25 and 26 are examined on the merits solely in regards to the elected species.

Specification

5. The amendment filed June 30, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the specification has been amended to change *Cistus monoperiensis* to *Cistus monspeliensis*. There is no evidence to support applicant's assertion that these are the same plants. Therefore, this amendment to the specification is considered to introduce new matter into the disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6. Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 19 and 20 have been amended to change *Cistus monoperiensis* to *Cistus monspeliensis*. There is no evidence to support applicant's assertion that these are the same plants. Without any evidence to support this change, applicant has added new matter by introducing a previously unrecited plant species into the claims. Therefore, this amendment to the claims is considered to introduce new matter.

Claim Rejections - 35 USC § 103

7. Claims 16, 19, 20, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamai (US 6,313,214) and Hadas (US 5,609,875) for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the data presented in the response show that the claimed composition produces unexpected results. However, these results are not considered to support a claim for unexpected results. The data presented in Table 1 appear to be qualitative judgments rather than quantifiable data. As discussed in MPEP section 716.02(b), the burden is on the applicant to show how offered data is of statistical significance. The qualitative data do not appear to be of statistical significance. Applicant has not discussed how these data are considered to be of statistical significance.

The data presented in Table 1 show the results from the combination of ingredient A with ingredient B, i.e. the elected species of *G. glabra*. In Table 2, applicant has shown the combination ingredient A with other known skin whiteners such as kojic acid, ellagic acid and arbutin. Applicant argues that the results in Table 1 are superior to the results in Table 2. Applicant argues that these superior results show the unexpected results. However, applicant has not provided any comparative data that can be used to determine the effectiveness of *G. glabra* when it is not combined with ingredient A. Without being able to separately evaluate the effectiveness of *G. glabra*, it cannot be determined if the results shown in Table 1 are actually synergistic rather than additive (see MPEP section 716.02(a)).

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Applicant also argues that the data presented in Table 3 show that Samples 13 and 14 (made according to the claimed invention) exhibit superior effects in comparison with Sample 15 (made according to Tamai). However, the results in Table 3 do not use a composition that contains elected species of *G. glabra*. Thus, even if the results of Table 3 did show unexpected results, these results would not sufficient to overcome the 103 rejection of the elected species.

8. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe Hoffman whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday-Thursday, 9:30-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Coe Hoffman/
Primary Examiner, Art Unit 1655